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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/761,524

01/21/2004

Robert Wham

2155 CIP CON

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11/03/2006

UNITED STATES SURGICAL,
A DIVISION OF TYCO HEALTHCARE GROUP LP
195 MCDERMOTT ROAD
NORTH HAVEN, CT 06473

EXAMINER

PEFFLEY, MICHAEL F

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/761,524

Applicant(s)

WHAM ET AL.

Examiner

Michael Peffley

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 28-60 is/are pending in the application.
- 4a) Of the above claim(s) 28-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's response of September 5, 2006 has been fully considered by the examiner. In particular, the objections to the specification and the drawings have been overcome, and applicant's terminal disclaimer is acceptable and has overcome the double patenting rejections. The following is a complete response to the September 5, 2006 communication.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller, III (5,836,943).

Miller discloses an electrosurgical system and method of treating tissue that comprises a controller for controlling the output pulses of the generator in response to measured tissue characteristics. In particular, Miller specifically teaches that impedance and/or rate of change of impedance is used to control the output of the generator in a method for treating tissue (col. 6, lines 13-61). As disclosed at column 12, lines 64 through column 13, line 10, tissue impedance is measured between pulses, and the generator is then regulated to control subsequent output pulses of the generator. Output pulses are controlled by varying the duty cycle and the magnitude of the output voltage (col. 10, lines 11-20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller, III ('943) in view of the teaching of Yates et al (5,558,671).

As addressed above, Miller discloses a system and method for controlling output pulses of a generator for coagulating (i.e. sealing) tissue by monitoring tissue impedance after a pulse (i.e. between pulses) and using the measured impedance to control subsequent pulses. Miller does not disclose the use of a look-up table as the means to arrive at the values for the subsequent pulses.

Yates et al disclose another tissue sealing device that relies on impedance feedback to control the output of an RF generator. In particular, Yates et al disclose various algorithms for controlling future application of energy based on the sensed impedance including using a look-up table to determine future energy applications (col. 8, lines 8-22).

To have provided the Miller, III system with a look-up table as a means to determine output levels for a generator in response to sensed tissue impedance would have been an obvious consideration for one of ordinary skill in the art in view of the teaching of Yates et al.

Response to Arguments

Applicant's arguments filed September 5, 2006 have been fully considered but they are not persuasive.

It is the examiner's position that applicant is attempting to read too much of the specification into the claims as written. That is, applicant is attempting to limit the definition of limitations based on what is written in the specification rather than based on the broadest reasonable interpretation. Applicant contends that the "characteristic of the electrical transient" is a waveform and not a single value. First, the examiner maintains that such a strict definition is not necessarily required by the claims as provided. Second, it is the examiner's position that the Miller reference uses the same "characteristic of an electrical transient", namely the rate of change of tissue impedance, for providing control out the output of subsequent pulses. Applicant's claim 7 clearly recites that the electrical transient is tissue impedance, and the at least one characteristic of the electrical transient is a rate of change of tissue impedance. Miller clearly uses the rate of change of electrical impedance to control subsequent pulses of energy in an RF system. See column 6, lines 13+ of Miller. Applicant has acknowledged in the response that Miller monitors the rate of change of impedance (applicant's response, page 17). It is not clear how applicant can assert that Miller is not performing the same control when the same characteristic of a measured electrical transient is used. That the Miller system may be a more conventional feedback system is not deemed to be germane to the argument since there is nothing specific in the claim

language that would preclude the use of a "conventional" feedback system to perform the functions set forth in the claim limitations.

With regard to the obviousness rejection involving the combination of the teaching of Yates with the Miller reference, applicant contends that Yates fails to cure the deficiencies of Miller. As argued above, the examiner maintains that the claimed limitations fail to set forth structure and/or steps that clearly distinguish over the Miller control system. Applicant further asserts that the Yates look-up table is very different from applicant's look-up table. Again, it is the examiner's position that applicant is improperly importing the subject matter of the specification into the claims. Yates provides a system for providing "conventional" feedback, much like Miller. Yates specifically teach of providing a linear control feedback whereby measured parameters control the output of the generator (like Miller) or an alternative feedback whereby measured parameters are associated with a look-up table which then provides the desired feedback. The examiner maintains that the Miller reference continues to anticipate claim 1, and that there is proper motivation for providing the Miller system with a look-up table to control the feedback system in view of the teaching of Yates.

Conclusion

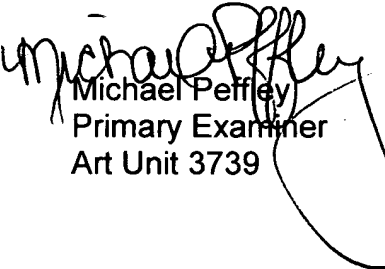
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Michael Petfley
Primary Examiner
Art Unit 3739

mp
October 30, 2006